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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/608,290
Filing Date: June 27, 2003
Appellant(s): ELLIOTT, JERRY E.

Thomas E. Hill
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/2/2006 appealing from the Office action mailed 12/23/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct. However, the arguments of the instant brief are persuasive with regards to claims 4-10, and therefore the rejections under 35 U.S.C. 103(a) directed to claims 4-10 are withdrawn.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because it contains superfluous information in regards to the background of the invention; however, a concise explanation of the subject matter defined in each of the independent claims involved in the appeal begins on page 5, line 15.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claims 1-3 and 11-40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 1,445,286 to Bosco in view of U.S. Patent No. 1,619,749 to Murray.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1,445,286	Bosco	2-1923
1,619,749	Murray	3-1927

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3 and 11-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 1445286, Bosco in view of US patent 1619749, Murray.

In regards to claim 1, Bosco discloses an apparatus comprising:

a body portion (13) having first and second opposed ends;

an arm (14) having a first end pivotally coupled to the body portion adjacent the first end thereof, the arm further including a second opposed end adapted for insertion in an aperture in the first edge flange of the repair clamp;

a clasp (15) pivotally coupled to the body portion intermediate the first and second opposed ends thereof and adapted to engage an outer edge of the repair

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clamp's second edge flange when the body portion is in a first position relative to the arm and clasp and the repair clamp is loosely disposed about the pipe, wherein pivoting displacement of the body portion about the arm and clasp to a second position draws the repair clamp's edge flanges together for securely maintaining the repair clamp on and in engagement with the pipe and allowing the nut and bolt combinations to be tightened for securing the repair clamp to the pipe in a sealed manner.

Bosco does not disclose an adjustable coupling means disposed in the body. Murray teaches an adjustable coupling means (17, 18 20 and 21) disposed in the body to provide a dead lock for the lever when in operation (lines 93-101). As Murray relates to clamps, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an adjustable means disposed in the body to provide a dead lock for the lever when in operation, as taught by Murray.

Note, **the repair clamp is not part of the claimed invention.**

In regards to claim 2, Bosco in view of Murray discloses the clasp includes a first end engaging the outer edge of the repair clamp's second edge flange and a second opposed end pivotally coupled to the adjustable means on the body portion.

In regards to claim 3, Bosco in view of Murray disclose a first pivot pin coupling the second end of the clasp to the adjustable means, wherein the adjustable means includes an elongated slot disposed in the body portion and having plural engaging members disposed in a spaced manner along the length of the slot for engaging the first pivot pin and establishing spacing between the arm and the clasp.

In regards to claim 11, Bosco in view of Murray disclose the arm and the clasp are disposed in closely spaced, aligned relation when the body portion is pivotally displaced to the second position.

In regards to claim 12, Bosco in view of Murray disclose a handle disposed on the second end of the body portion.

In regards to claim 13, Bosco in view of Murray disclose the handle is comprised of rubber or an elastomeric material.

In regards to claim 14, Bosco in view of Murray disclose the second end of the arm includes a hook structure for insertion into the aperture when the body portion is in the first position, and wherein the hook structure cannot be removed from the aperture when the body portion is in the second position for locking the repair clamp in position on the pipe.

In regards to claim 15, Bosco in view of Murray disclose the aperture is in the form of a slot and the hook structure includes first and second coupled flat portions having approximately 90 degrees relative orientation.

In regards to claim 16, Bosco in view of Murray disclose the clasp is generally C-shaped and includes an elongated slot for engaging an outer edge of the repair clamp's second edge flange.

In regards to claim 17, Bosco in view of Murray disclose the apparatus is comprised of high strength steel.

In regards to claim 18, Bosco in view of Murray disclose first and second pins attached to the body portion for pivotally coupling the clasp and arm, respectively, to the

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body portion, and wherein the second pin forms an axis of rotation about which the body portion rotates when moved between the first and second positions.

In regards to claim 19, Bosco in view of Murray disclose the first and second pins and an end portion of the clasp engaging an outer edge of the repair clamp's second edge flange are in general linear alignment when the body portion is in the second position.

In regards to claim 20, Bosco in view of Murray disclose the body portion is pivotally displaced about the second pin in moving the body portion from the first to the second position in removing the apparatus from the repair clamp.

In regards to claim 21, Bosco in view of Murray disclose an apparatus comprising: an elongated body having first and second opposed ends and an intermediate portion disposed therebetween; an arm having a first end pivotally coupled to the body adjacent the first end thereof by means of a first pivot pin and a second opposed end adapted for insertion in an aperture in the first edge flange of the repair clamp; a clasp pivotally coupled by means of a second pivot pin to the body intermediate the first and second opposed ends thereof and adapted to engage an outer edge of the repair clamp's second edge flange when the body is in a first position relative to the repair clamp and the repair clamp is loosely disposed about the pipe, wherein pivoting displacement of the body about the first pivot pin in a direction away from the repair clamp's second edge flange to a second position relative to the repair clamp draws the second end of the arm and the clasp as well as the repair clamp's first and second edge flanges together, and wherein the inner liner and cylindrical body of

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the repair clamp are securely maintained in engagement with the pipe about its outer periphery allowing the nut and bolt combinations to be tightened for securing the pipe clamp to the pipe in a sealed manner, wherein the arm and the clasp may be disengaged and removed from the edge flanges and the apparatus removed from the repair clamp following tightening of the nut and bolt combinations; and adjustable coupling means disposed in the elongated body for coupling the clasp to the elongated body while allowing for changing spacing between the arm and the clasp to accommodate a range of sizes of the repair clamp and diameters of the pipe.

Note, **the repair clamp is not part of the claimed invention.**

In regards to claim 22, Bosco in view of Murray disclose the body includes first and second spaced, generally parallel members, with the first and second pins disposed between and coupled to the first and second members.

In regards to claim 23, Bosco in view of Murray disclose a handle disposed on the second end of the body.

In regards to claim 24, Bosco in view of Murray disclose the handle is comprised of rubber or an elastomeric material.

In regards to claim 25, Bosco in view of Murray disclose the second end of the arm includes a hook structure for insertion into the aperture when the body is in the first position, and wherein the hook structure cannot be removed from the aperture when the body is in the second position for locking the repair clamp in position on the pipe.

In regards to claim 26, Bosco in view of Murray disclose the aperture is in the form of a slot and the hook structure includes first and second coupled flat portions having generally 90 degrees relative orientation. .

In regards to claim 27, Bosco in view of Murray disclose the clasp is curvilinear in shape having a first end coupled to the second pivot pin and a second opposed end engaging the outer edge of the repair clamp's second edge flange.

In regards to claim 28, Bosco in view of Murray disclose the second end of the clasp is generally in the form of a hook.

In regards to claim 29, Bosco in view of Murray disclose the apparatus is comprised of high strength steel.

In regards to claim 30, Bosco in view of Murray disclose the first pin forms an axis of rotation about which the body rotates when moved between the first and second positions.

In regards to claim 31, Bosco in view of Murray disclose the first and second pins and the second end of the clasp are in general linear alignment when the body is in the second position.

In regards to claim 32, Bosco in view of Murray disclose the adjustable means changes spacing between the arm and the clasp, bringing the arm and clasp closer together for smaller pipe clamps and pipe diameters and moving the arm and clasp apart for larger pipe clamps and pipe diameters.

In regards to claim 33, Bosco in view of Murray disclose the clasp includes a first end engaging the outer edge of the repair clamp's second edge flange and a second opposed end pivotally coupled to the second pivot pin.

In regards to claim 34, Bosco in view of Murray disclose the adjustable means includes an elongated slot disposed in the body portion and having plural engaging members disposed in a spaced manner along the length of the slot for engaging the first pivot pin and establishing spacing between the arm and the clasp.

In regards to claim 35, Bosco in view of Murray disclose each of the engaging members includes a pair of concave recesses in facing relation within the elongated slot, with plural pairs of facing concave recesses disposed in a spaced manner along the length of the elongated slot, and wherein each pair of facing concave recesses securely engages the first pivot pin in a releasable manner.

In regards to claim 36, Bosco in view of Murray disclose the clasp includes a first hook disposed on its first end for engaging the outer edge of the repair clamp's second edge flange and a second hook disposed on its second opposed end and positioned about the second pivot pin.

In regards to claim 37, Bosco in view of Murray disclose the second pivot pin includes a first pair of opposed convex portions and a second pair of opposed flat portions disposed in an alternating manner about its circumference, and wherein the convex portions are adapted for secure engagement with opposed facing pairs of concave recesses in the elongated slot for fixedly coupling the clasp to the body portion, and wherein the second pivot pin is movable along the length of the slot for

repositioning the first pivot pin within the slot when the opposed flat portions of the first pivot pin are in facing relation to the opposed convex portions of the slot.

In regards to claim 38, Bosco in view of Murray disclose the body portion includes first and second connected members forming a handle at respective first connected ends thereof.

In regards to claim 39, Bosco in view of Murray disclose second opposed ends of the first and second members are arranged in a spaced manner from each other and wherein the arm and the clasp are disposed between the first and second members adjacent the second ends thereof.

In regards to claim 40, Bosco in view of Murray disclose the arm and the clasp are disposed in closely spaced, aligned relation when the body portion is pivotally displaced to the second position.

(10) Response to Argument

In response to remarks on the rejection of claims 1 and 21 under 35 U.S.C.

103(a):

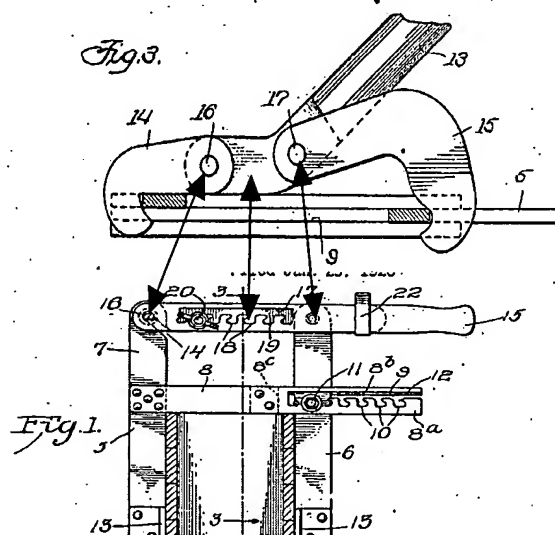
Appellant contends that neither Bosco nor Murray function as a repair clamp as the claimed invention, and the preamble of claims 1 and 21 is necessary to give life, meaning, and vitality to these claims. The Examiner stated in the Final Office Action filed 12/23/2005, and the Non-Final Office Action filed 9/8/2005 that the repair clamp is not part of the claimed invention because its recitation had not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a

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process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The structure of the claims 1 and 21 is clearly understood by one having ordinary skill in the art, and the preamble fails to give life, meaning or vitality to these claims which do not depend on the preamble for completeness; therefore, the preamble is not accorded any patentable weight because it merely recites the purpose of a process or the intended use of claimed apparatus.

Further, as generally set out in *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed Cir 1997), during examination, statements in a claim reciting the purpose or intended use of the claimed invention must be evaluated to determine whether such recited purpose or intended use results in a structural difference between the claimed invention and the prior art applied by the Examiner. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (*Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if the prior art clamping apparatus in *Bosco* in view of *Murray* is capable of performing the function or intended use as recited in claims 1 and 21, then it meets the claim.

Appellant contends to incorporate the structure in the Murray clamp relied upon by the Examiner in rejecting the pending claims would require the incorporation of a hinged coupling in Bosco's claw 15 which is not shown in Bosco and which would prevent this reference from operating as intended, nor would the combination suggested by the examiner operate as the apparatus recited in pending claims 1 and 21. The Examiner states that Figure 3 of Bosco and Figure 1 of Murray, both represented below clearly illustrate how the modification of Bosco by Murray would have been obvious to one having ordinary skill in the art.



The modification involves the adjustable means (17, 18 20 and 21) of Murray modifying the body portion (13) of Bosco to meet the limitations of the claimed invention.

Reference pins 16 and 17 of Bosco are represented by their respective reference pins 16 and 20 in Figures 1 and 3 above. Presumably, elements 7 and 6,19 of Murray can be equated to elements 14 and 15 of Bosco. Therefore, to incorporate the structure in the

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Murray clamp does not require the incorporation of a hinged coupling in Bosco's claw 15 and does not prevent this reference from operating as intended, and the combination suggested by the Examiner would operate as the apparatus recited in pending claims 1 and 21.

Appellant contends that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as both Bosco and Murray relate to clamps, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an adjustable means disposed in the body of Bosco to provide a dead lock for the lever when in operation, as taught by Murray.

Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, the combination of Bosco and Murray establishes a prima facie case of obviousness with three basic criteria met. First, there is a suggestion or

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motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there is a reasonable expectation of success. Finally, the prior art reference, or references when combined, teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success is found in the prior art and is not be based on Appellant's disclosure.

Appellant contends that these two references, Bosco and Murray, teach away from one another because one concrete form requires an installation tool while the other does not. The Examiner states the two prior art reference do not teach away from one another just because each reference has a different intended use. The Examiner's position is simply that if there are differences between two references are insufficient to establish that such references "teach away" from any combination thereof. In re Beattie, 974 F.2d 1309, 1312-13, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

In response to remarks on the rejection of claim 2 under 35 U.S.C. 103(a):

Appellant contends that Bosco's tool is not adjustable and thus does not include adjustable means. Examiner states that modification of Bosco with Murray is implied to all rejected claims, since the grounds of rejection are; "Claims 1-3 and 11-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 1445286, Bosco in view of US patent 1619749, Murray." Therefore, Bosco's tool, modified with the Murray adjustable means, is not adjustable and thus does include adjustable means.

In response to remarks on the rejection of claim 3 under 35 U.S.C. 103(a):

Appellant contends the Examiner ignores link lever 19 pivotally coupled to both handle 15 and the second end of jaw 6 for pivotally coupling these two members; and incorporating the equivalent of Murray's link lever 19 between the inner end of Bosco's claw 15 and Bosco's lever arm/handle 13 would render the Bosco tool inoperable because of the incorporation of an additional pivot point (pivot pin 11 in Murray) between Bosco's claw 15 and Bosco's lever arm handle 13 which would prevent Bosco's tool from operating as intended. Examiner states that as illustrated in Figure 1 and 3 above. The modification involves the adjustable means (17, 18, 20 and 21) of Murray modifying the body portion (13) of Bosco to meet the limitations of the claimed invention. Reference pins 16 and 17 of Bosco are represented by their respective reference pins 16 and 20 in Figures 1 and 3 above. Presumably, elements 7 and 6,19 of Murray can be equated to elements 14 and 15 of Bosco. Therefore, to incorporate the structure in the Murray clamp does not require the incorporation of a hinged coupling in Bosco's claw 15 and does not prevent this reference from operating as intended, and the combination suggested by the Examiner would operate as the apparatus recited in the pending claim.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Aaron Dunwoody

A handwritten signature in black ink, appearing to read 'A. Dunwoody', with a long horizontal flourish extending to the right.

Conferees:

Daniel P Stodola 

David Bochna 